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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,016	07/08/2003	Marie-Laure Delacour	05725.1224-00	9511

22852 7590 09/17/2007  
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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WASHINGTON, DC 20001-4413

EXAMINER
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CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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09/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/614,016	<b>Applicant(s)</b> DELACOUR ET AL.	
	<b>Examiner</b> Lakshmi S. Channavajjala	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Receipt of response and amendment dated 6-8-07 is acknowledged.

Claims 1-63 are pending.

#### ***Response to Arguments***

Applicant's arguments filed 6-8-07 have been fully considered but they are not persuasive.

##### Double patenting rejection:

In response to the double patenting rejection of instant claims 1-63 over US Patent No. 6,403,704, applicants stated that the patent has expired due to non-payment of maintenance fee and hence the rejection is moot. Applicants' arguments are persuasive and therefore the rejection has been withdrawn.

Applicants' argument with respect to the double patenting rejection over US 7,094,842, that the silicone polymer of the patent is not an elastomer is persuasive and accordingly the rejection has been withdrawn.

##### Double patenting rejection over US Patents 6565862 ('862), 6689345 ('345) and 7-94842 ('842):

Applicants' argue that '862 was filed before the instant invention and that under one-way test, office did not show the prima facie obviousness requirements. It is argued that there is nothing in the claims of '862 patent to provide a reason to pick and choose

the claimed ratios of organopolysiloxane to particulate phase and hence a skilled artisan cannot optimize the composition of '862. It is argued that the examiner failed to provide any reason (under the one-way test) to modify '345 patent to arrive at the presently claimed composition. Applicants' arguments are not persuasive because '862 patent also claims a cosmetic composition such as the instant and for the same purpose i.e., see instant claim 58 and claim 17 of '862. Similarly, '345 patent claims a make-up composition, which is also claimed in the instant dependent claims. The amounts of particle phase and organopolysiloxane are within the claimed ranges and siloxane polymer of '862 recites the same hardness. Accordingly, a skilled artisan would have been motivated to modify the amounts of particulate phase and the organopolysiloxane (suspended in the aqueous phase) so as to arrive at the various claimed cosmetic compositions.

Claims 1-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,403,704 ('704) or US 6,689,345 ('345) or US 6,565,862 ('862) or US 7,094,842 ('842) or US 6,184,277 ('277):

Applicants argue that the office failed to meet the criteria i.e., "reason why person of ordinary skill in the art would have combined the prior art elements in the manner claimed", as required by KSR Int'l Co. v. Teleflex, Inc.

With respect to the teachings of patents '704, '862 and '345, it is argued that the above patents fail to teach or suggest the claimed ratios of organopolysiloxane to particulate phase (of claim 1). However, the above patents teach the claimed

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components (organopolysiloxane, particulate materials and other auxiliary materials of the instant claims) for the same purpose i.e., preparing cosmetic compositions such as make-up compositions, foundations, eyeliner etc. In particular, '862 teach the composition to be a transfer-resistant composition, with the amount and hardness of organopolysiloxane in the same range as in the instant claims (see col. 2) for the particulate phase, instant dependent claims recite components such as fillers, pigments etc., all of which are described by '862 in similar amounts (col. 7). Similarly, '345 Patent also teaches the same make-up compositions as that of the instant that provide softness and freshness, with the overlapping amounts of individual components (col. 3, L 19-22; col. 6, L 4-20 (same organopolysiloxane as described in the instant application), col. 9, L 35-col. 10, 32, all of which are claimed and described in the instant application). With respect to '704, the patent also teaches water-resistant cosmetic composition, comprising the same organopolysiloxane (col. 4, for the claimed hardness, amounts and particle size) and particulate phase having the claimed fillers, pigments, dyestuff etc (col. 7). The amounts of individual components described in the prior art overlap with that of instant claims. Thus, the scope and content of the cited prior art is the same as that of the instant invention and hence preparing a cosmetic composition as that of the instant invention by optimizing the amounts of the individual components (thus varying their ratios) would have been within the scope of a skilled artisan, with a reasonable expectation of preparing a transfer-resistant cosmetic composition.

With respect to the teachings of '6184277 patent ('277), it is argued that examiner admits the lack of teaching of the claimed ratios of A and B. It is argued that the compositions are oil-based and therefore the aqueous suspensions have not been described and that one skilled in the art would not be able to modify the composition of '277 to arrive at the instant. Applicants arguments are not persuasive because '277 teaches addition of gelling agents in an aqueous phase (col. 4), which is exemplified as gelled dispersion composition for skin care. Thus, the prior art does provide the requisite motivation to incorporate an aqueous phase in the composition containing organopolysiloxane.

Applicants' argument with respect to the rejection over US 7,094,842, that the silicone polymer of the patent is not an elastomer is persuasive and accordingly the rejection has been withdrawn. Applicants' argument with respect to the rejection over US 5928660, that the silicone rubber is coated with the powder particles and not suspended as in the instant and also that the amounts of the powder particles to silicone rubber of the '660 (0.1-50 parts per 100 parts of powdered silicone is persuasive and accordingly the rejection has been withdrawn. For the same reasons the rejection of claims 21-24 and 27-31 9as being rejected over '660 in view of JP) have been withdrawn.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

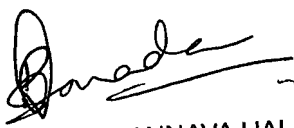
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615  
September 13, 2007



LAKSHMI S. CHANNAVAJJALA  
PRIMARY EXAMINER